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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,905	01/31/2005	Harry Richard Claringburn	P62303	1397
15% 7590 12/03/2009 Kirschstein, Israel, Schiffmiller & Picroni, P.C. 425 FIFTH AVENUE 5TH FLOOR NEW YORK, NY 10016-2223				
EXAMINER LIU, LI				
ART UNIT 2613		PAPER NUMBER		
NOTIFICATION DATE 12/03/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/500,905

Applicant(s)

CLARINGBURN ET AL.

Examiner

LI LIU

Art Unit

2613

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 9, 10, 12, 13, 15 and 16.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Li Liu/
Examiner, Art Unit 2613

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant's arguments filed on have been fully considered but they are not persuasive, and do not place the application in condition for allowance.

1). Applicant's argument - "As previously argued, Corio has nothing to do with optical telecommunications networks, but with laser printing/writing devices. Applicants respectfully submit that Corio is not reasonably pertinent to the particular problem with which the applicants were concerned".

Examiner's response - Corio discloses that when the variable attenuator is used for power controlling, the output power of the laser needs be operating at maximum so that the attenuator can properly control or attenuate the power of the laser output and obtain the desired power level. In applicant system, "the optical sources being added are run at maximum power and their output amplitude controlled by the respective VOA assigned to that channel" (refer to claims 9 etc and the applicant specification: page 6 line 19 to page 7 line 2). That is, reference Corio is reasonably pertinent to the particular problem with which the applicant was concerned: set the output power of the light source at maximum power so that the variable attenuator can be used to control the amplitude of the light signal to be added.

2). Applicant's argument - "Applicants further submit that claim 9 has been misread. Claim 9 is not, as the Examiner proposed, concerned with the problem of "setting the output power of the light source at maximum power so that variable attenuator can be used to control the amplitude of the light signal to be added". Instead, claim 9 is concerned with the problem of improving the optical signal-to-noise ratio ("OSNR"), in the add path of an optical network node operating in an n-channel DWDM network. There is an optical amplifier in the add path of claim 9 that adds optical noise, and this has a negative impact on the OSNR. Applicants have proposed dealing with this negative impact". "In Corio, OSNR is not a problem at all. ...".

Examiner's response - First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., optical signal-to-noise ratio "OSNR") are not recited in the rejected claim 9. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, claim 9 states "a multichannel wavelength selective filter with variable-per-channel attenuation for blocking channels not carrying signals to be added to the network or controlling an amplitude of the added signals, ... , and the node further comprising means for running sources for generating the n-channel signals at maximum power"; and the original specification also discloses "[t]he optical sources being added are run at maximum power and their output amplitude controlled by the respective VOA 144 assigned to that channel" (page 6 line 24 to page 7 line 2). That is, "setting the output power of the light source at maximum power so that variable attenuator can be used to control the amplitude of the light signal to be added" is concerned in the claim and the disclosure, and the claim 9 is not "misread".

3). Applicant's argument - "The following factors also place laser solutions for laser printing very remotely from solutions applicable to optical communications networks: ..." (REMARKS: pages 3-4).

"In consequence, the problems and solutions used in printers are vastly different from the ones used in DWDM networks. Corio is not reasonably pertinent to the particular problems with which the applicants were concerned".

Examiner's response - As argued in the previous Final Office Action and also stated above, Corio teaches that by setting the laser (laser 12) at maximum power, the variable attenuator can accurately (fine tune) control/adjust the power level that can be inputted into the fiber. Corio is reasonably pertinent to the particular problems with which the applicants were concerned. The reference Corio is used to combine with Caroli to teach that while the variable attenuator is used for control the power level of a light source, the power of the light source needs be running at maximum power so that the variable attenuator can be used to control the amplitude of the light signal to be added. According to the teaching/suggestion of Corio and it is also obvious that if the light source is run at minimum power, a desired power may not be obtained by the VOA since the VOA functions as an attenuating not amplifying, or the VOA may not fully participate in controlling the power: suppose the laser power can be set between -1 dBm to 5 dBm, while the laser is run at -1 dBm, the channel power that can be sent to the transmission line can only be adjusted to less than or equal to -1 dBm, and if the transmission line needs 2 dBm channel power, the laser/VOA cannot provide that desired power; however, while the laser is run at 5 dBm, the maximum channel power that can be sent to the transmission line can reach up to 5 dBm, by using the VOA, the channel power can be adjusted/tuned to the desired power, e.g., 2 dBm.

4). Applicant's argument - "The claims of the present invention must be analyzed from a position of a skilled person having knowledge of the prior art just before the priority date of the present application. However, applicants respectfully submit that the Examiner used the knowledge learned from the present invention in order to pick remote parts of unrelated prior art documents and combine them to arrive at the present invention. The Examiner ignored the teaching of each independent claim as a whole, and the problem solved by each independent claims and, instead, focused on a part of the solution offered by each independent claim. This approach, however, should not be used. When obviousness of an invention is analyzed by starting from the inventive solution, the person analyzing the claim is biased by the knowledge of the invention".

Examiner's response - In response to applicant's argument that "[t]he examiner used the knowledge learned from the present invention", it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the primary reference Caroli et al teaches that the wavelength blocker with variable-per-channel attenuation (DGEF) blocks channels not carrying signals to be added to the network or controlling an amplitude of the added signals, and minimizing unwanted spontaneous emission ASE noise, and then the signal to noise ratio is increased; as discussed above, if the sources are running below a predetermined level, the DGEF or attenuator would not fully participate in the controlling, and the desired power level may not be obtained. Corio teaches that by setting the laser at maximum power, the variable attenuator can accurately control/adjust the power level that can be inputted into the fiber. The combination of Caroli and Corio teaches that while the variable attenuator is used to control the power level of a light source, the power of the light source needs be running at maximum power so that the amplitude of the light signal to be added can be accurately controlled/adjusted by the variable attenuator to a desired level. That is, "the present invention" is "analyzed from a position of a skilled person having knowledge of the prior art just before the priority date of the

present application" and the Examiner did not ignore "the teaching of each independent claim as a whole, and the problem solved by each independent claims".

5). Applicant's argument - Caroli relates to a WDM add/drop node, and not laser printers. For the reasons set out above, the applicants believe that a person skilled in the art of optical telecommunications networks would not attempt to combine Caroli and Corio, because there is no motivation to do so, and because these two documents relate to remote fields of technology.

Examiner's response -In response to applicant's argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as discussed above, Caroli et al teaches that the wavelength blocker with variable-per-channel attenuation blocks channels not carrying signals to be added to the network or controlling an amplitude of the added signals, and minimizing ASE noise, and then the OSNR is increased. Corio teaches that by setting the laser (laser 12) at maximum power, the variable attenuator can accurately (fine tune) control/adjust the power level that can be inputted into the fiber. Corio is reasonably pertinent to the particular problems with which the applicants were concerned. Therefore, it would be obvious to combine Caroli et al with Corio so that the gain equalizer/attenuator can perform the full function to conveniently and accurately control the output channel power to a desired level, and the desired OSNR can be obtained..